

## **REMARKS**

This is a full and timely response to the outstanding non-final Office Action mailed February 28, 2006. Reconsideration and allowance of the application and pending claims are respectfully requested.

### **I. Specification Objection**

The specification has been objected to for containing various informalities. Specifically, the Office Action identifies that page 4 is missing the serial number for the U.S. patent application that is being incorporated by reference.

In response to the objection, Applicant has amended the specification to provide the missing serial number. In view of that amendment, Applicant respectfully submits that the specification is not objectionable, and therefore respectfully requests that the objection be withdrawn.

### **II. Claim Rejections - 35 U.S.C. § 112, First Paragraph**

Claims 1-19 and 21-32 have been rejected under 35 U.S.C. § 112, first paragraph, as comprising subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor had possession of the claimed invention.

Applicant disagrees that Applicant's independent claims contain subject matter that was not adequately described in the specification. Although Applicant did not explicitly describe generating a notification that explicitly identifies that "folding" and "sealing" has occurred, Applicant submits that such actions are inherent in the "generation" of a "print-to-mail format document" in accordance with the definition of that term provided by Applicant in the original specification. *See, e.g., Applicant's specification*, page 1, lines 14-19; page 5, lines 3-4. Therefore, by notifying that a

“print-to-mail format document” has been “generated” inherently notifies that a document has been printed, folded, and sealed.

Despite Applicant’s disagreement with the rejection, Applicant has amended each independent claim to clarify that the notifications identify that a print-to-mail format document has been “generated”, thereby “indicating” that the document has been “printed, folded, and sealed as a mailing”.

In view of the above, Applicant respectfully requests that the rejection of these claims under 35 U.S.C. § 112, first paragraph, be withdrawn.

### **III. Claim Rejections - 35 U.S.C. § 103(a)**

As has been acknowledged by the Court of Appeals for the Federal Circuit, the U.S. Patent and Trademark Office (“USPTO”) has the burden under section 103 to establish a *prima facie* case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. *See In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988). The Manual of Patent Examining Procedure (MPEP) section 2143 discusses the requirements of a *prima facie* case for obviousness. That section provides as follows:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable

expectation of success must both be found in the prior art, not in applicant's disclosure.

In the present case, the prior art at least does not teach or suggest all of the claim limitations.

**A. Rejection of Claims 1-7, 12-15, 18, 21, 26-29, and 32**

Claims 1-7, 12-15, 18, 21, 26-29, and 32 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Tammi* (U.S. Patent No. 5,726,897) in view of *Gleason* (U.S. Pat. No. 5,091,777). Applicant respectfully traverses this rejection.

*Tammi* discloses a mail assembly system wherein non-printable post processing data is embedded within mail statement print data and used to control "post processing" of mailing pieces. *Tammi*, column 3, lines 18-22.

As described by *Tammi*, data records comprising mailing statement print data (which comprise the embedded post processing data) are stored in a data storage means. *Tammi*, column 3, lines 23-32. During operation of *Tammi*'s system, a printer receives a stream of mailing statement print data and sequentially outputs printed sheets according to the print data. *Tammi*, column 5, lines 23-28. During that process, the embedded post processing data is split off from the stream of statement print data by a "splitter device" and is directed to a "system controller computer." *Tammi*, column 5, lines 28-34.

As the printed sheets are output by the printer, each printed sheet is transferred to a "post processing system" by a "finishing interface". *Tammi*, column 5, lines 34-37. *Tammi* states that the finishing interface sends signals to the system controller computer: (a) when each printing sheet is transferred to the post processing system by the finishing interface, and (b) when a final printed sheet of each mailing statement clears the finishing interface and enters the post processing system.

*Tammi*, column 5, lines 37-49. The system controller computer then uses those signals to match the parity of the post processing data received from the splitter device with the parity of the mailing statement to direct the post processing operations carried out by the post processing system for each mailing piece. *Tammi*, column 5, lines 56-62. *Tammi* states that the “post processing” of the printed sheets includes folding the sheets, inserting them into envelopes, sealing the envelopes, etc. *Tammi*, column 5, lines 16-22.

Significantly, nowhere does *Tammi* state that signals are provided to the system control computer after post processing is completed. Instead, as is apparent from the above, signals are only provided to the system controller computer so that the computer can control such post processing. Therefore, the signals provided to the system controller computer do not identify that any statements or other documents have been folded and sealed.

In view of the above, Applicant submits that *Tammi* does not teach or suggest the limitations that the Examiner argues *Tammi* teaches. Regarding independent claim 1, *Tammi* does not teach or suggest “determining that a print-to-mail format document has been generated by printing, folding, and sealing the document as a mailing”. *Tammi* instead only teaches determining that printed sheets of mailing statements have “entered” a post processing system. *Tammi* describes no determination that folding and/or sealing has occurred. As a further point, *Tammi* does not teach or suggest “generating notification information that identifies that the print-to-mail format document has been generated, thereby indicating that the document has been printed, folded, and sealed as a mailing”. Again, *Tammi*’s system controller computer only receives signals in regard to entry of printed sheets into the post processing system, not as to any folding and/or sealing operations.

Regarding independent claim 12, Tammi does not, as is argued by the Examiner, teach “means for determining that a print-to-mail format document has been generated by printing, folding, and sealing the document as a mailing” or “means for generating notification information that identifies that the print-to-mail format document has been generated, thereby indicating that the document has been printed, folded, and sealed as a mailing” at least for reasons described above in relation to claim 1.

Regarding independent claim 18, Tammi does not, as is argued by the Examiner, teach a “print-to-mail device” comprising “hard copy generation hardware”, “a folding mechanism”, and “a sealing mechanism”. As described above, Tammi only teaches a printer and a *separate* post processing system. Furthermore, Tammi does not teach a print-to-mail notifier configured to generate notification information pertinent to “generating of print-to-mail documents that have been printed, folded, and sealed by the print-to-mail device as a mailing”. Again, Tammi’s system controller computer only receives signals in regard to entry of printed sheets into the post processing system, not as to any folding and/or sealing operations.

Regarding independent claim 28, Tammi does not, as is argued by the Examiner, teach device comprising “a print engine configured to print documents”, “a folding mechanism configured to fold the printed documents”, and “a sealing mechanism configured to seal the folded documents”. Again, Tammi only teaches a printer and a *separate* post processing system. Furthermore, Tammi does not teach a print-to-mail notifier configured to generate a notification that confirms “generation of multiple print-to-mail format documents and thereby confirms printing, folding, and sealing of the multiple documents as mailings”. Again, Tammi’s system controller computer only receives signals in regard to entry of printed sheets into the post processing system, not as to any folding and/or sealing operations. Moreover, Tammi does not

teach that “the mailings do not require an envelope to be mailed”. To the contrary, as described above, Tammi explicitly states that the printed “sheets” *are* placed in envelopes in order to mail them. Therefore, Tammi fails to teach “print-to-mail format documents” as defined by Applicant.

Given that Gleason does not provide teachings or suggestions that would remedy the shortcomings of the Tammi disclosure, Applicant submits that independent claims 1, 12, 18, and 28, and their dependents, are allowable over the Tammi/Gleason combination.

**B. Rejection of Claims 8-10, 16, 19, 24, 25, 30, and 31**

Claims 8-10, 16, 19, 24, 25, 30, and 31 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Tammi* in view of *Gleason* in view of *Stewart* (U.S. Pat. No. 6,714,964). Applicant respectfully traverses this rejection.

As identified above, Tammi and Gleason do not teach several aspects of Applicant’s claims. In that *Stewart* does not remedy the deficiencies of the Tammi and Gleason references, Applicant respectfully submits that claims 8-10, 16, 19, 24, 25, 30, and 31 are allowable over the Tammi/Gleason/*Stewart* combination for at least the same reasons that claims 1, 12, 18, and 28 are allowable over Tammi/Gleason.

**C. Rejection of Claims 11 and 17**

Claims 11 and 17 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Tammi* in view of *Gleason* in view of *Stewart* and further in view of *Pollard* (U.S. Pat. No. 5,745,590). Applicant respectfully traverses this rejection.

As identified above, Tammi, Gleason, and Stewart do not teach several aspects of Applicant's claims. In that Pollard does not remedy the deficiencies of the Tammi, Gleason, and Stewart references, Applicant respectfully submits that claims 11 and 17 are allowable over the Tammi/Gleason/Stewart/Pollard combination for at least the same reasons that claims 1 and 12 are allowable over Tammi/Gleason/Stewart.

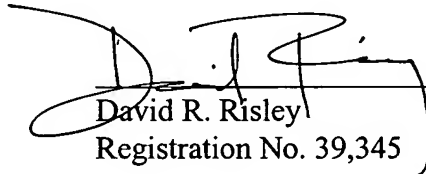
#### **IV. New Claims**

Claims 33-35 have been added into the application through this Response. Applicant respectfully submits that these new claims describe an invention novel and unobvious in view of the prior art of record and, therefore, respectfully requests that these claims be held to be allowable.

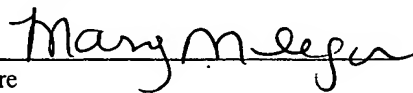
### CONCLUSION

Applicant respectfully submits that Applicant's pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,

  
David R. Risley  
Registration No. 39,345

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